



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0807-00000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
Isabelle ROLLAT-CORVOL et al.) Group Art Unit: 1617
Application No.: 09/719,101)
Filed: February 23, 2001)
For: COSMETIC COMPOSITION) Confirmation No.: 4969
COMPRISING AT LEAST ONE TACKY)
POLYMER AND AT LEAST ONE)
FIXING POLYMER)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer dated June 11, 2008 ("the Answer"). A Request for Oral Hearing is concurrently filed with this Reply Brief.

Appellants do not believe that a fee is due in connection with the filing of this paper. However, if any fees are required in connection with the filing of this paper, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

REMARKS

I. STATUS OF REJECTIONS

In response to the amended Appeal Brief filed April 10, 2008 ("the Appeal Brief"), the Examiner has:

(1) withdrawn the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106

under the judicially created doctrine of obviousness-type double patenting in view of the Terminal Disclaimer filed in this application on July 27, 2007;

(2) maintained the rejection of claims 38-43, 45-50, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; and

(3) maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 103(a) as being unpatentable over EP 0 551 749 to Lee et al. ("Lee") in view of WO 95/18191 to Miller et al. ("Miller").

II. RESPONSE TO EXAMINER'S ARGUMENTS IN THE ANSWER

A. Claims 38-43, 45-50, 69, 78, 79, 83, 84, and 88-106 comply with the written description requirement

In the Answer, the Examiner maintains the rejection under § 112, first paragraph, asserting that "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are directed to composition comprising polymers which are solely defined by physical properties 'tacky,' Tg, F_{max}, or E_{s(M/V)}, etc." Answer at 3. Further, the Examiner alleges that "a screen method for finding a compound is not a proper written

description for the compound.” *Id.* at 6 (citing *University of Rochester v. G.D. Searle & Co., Inc., et al.*, 358 F.3d 916, 920-23, 69 USPQ2d 1886, 1894-1895 (Fed. Cir. 2004)).

Id. at 5. Appellants respectfully disagree, and reiterate that the Examiner continues to misapply the *University of Rochester* case.

As set forth in the Appeal Brief, the court in the *University of Rochester* case stated that

It is undisputed that the ‘850 patent **does not disclose any compounds** that can be used in its claimed methods. The claimed methods **thus** cannot be practiced based on the patent’s specification, even considering the knowledge of one skilled in the art.

Univ. of Rochester, 358 F.3d at 918, 920; 69 USPQ2d at 1888-89, 1895 (emphasis added). In contrast, the as-filed original Specification in the present application discloses multiple specific embodiments of a “tacky polymer” as presently claimed. See, e.g., Specification at 6-12 and Examples 1 and 2. Accordingly, the facts and holdings of the *University of Rochester* case simply do not apply to the situation at hand. Appellants additionally submit that the Answer conveniently fails to respond to Appellants’ arguments previously presented regarding the *University of Rochester* case, which explained how the facts of *Rochester* do not apply here.

In the Answer, the Examiner merely states that “Appellants further contend that the specification provide reasonable description for the polymer claimed, citing page 7-12. It is noted that page 7-12 merely disclose examples of two preferred embodiments. . . . The application provides no written description as to the structure-function relationship.” Answer at 5. This position is not understood by Appellants because the disclosure contains identifying characteristics of the claimed polymers.

As previously emphasized in the Appeal Brief, the present Specification in fact defines the chemical properties and the structure of polymers according to the present claims as well as their physical properties and functional characteristics. This disclosure fully satisfies the written description requirement of § 112, first paragraph, which may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, **or** by disclosure of **relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties**, by functional characteristics coupled with a known or disclosed correlation between function and structure, **or** by a **combination of such identifying characteristics**, sufficient to show the applicant was in possession of the claimed genus. See *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998).

Simply put, the as-filed original Specification contains such a combination of structure, chemical and physical properties with respect to the claimed polymers – exactly the type of disclosure that the Federal Circuit has deemed sufficient to satisfy the written description requirement. Accordingly, reversal of this rejection is requested.

B. 38-58, 60, 69, 78, 79, 83, 84, and 88-106 are patentable under 35 U.S.C. § 103(a)

In the Answer, the Examiner maintains the rejection under 35 U.S.C. § 103(a), asserting again that

it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to modify Lee's composition by using the branched sulfonic polyester as the water-dispersible resin [and that a] person of ordinary skill in the art would have been motivated

to modify Lee's composition by using the branched sulfonic polyester as the water-dispersible resin because the branched sulfonic polyester will not become brittle or lost its property at low temperature.

Answer at 5. Appellants disagree.

As set forth in the Appeal Brief, Appellants respectfully submit that the rejection under § 103 is improper for at least the reason that the references relied upon, *Lee* and *Miller*, when considered **as a whole**, include portions that would discourage the modification and combination suggested by the Examiner. In fact, in order to arrive at compositions resembling those presently claimed, one would need to modify hairstyling compositions according to *Lee* in a manner that *Miller* explicitly teaches would render the resulting compositions unsatisfactory for *Lee*'s intended purpose. Such a modification would not be obvious due to the divergent properties and requirements between the hairstyle composition of *Lee* and the hot-melt adhesives of *Miller*.

In the Answer, the Examiner asserts that “[i]n this case, the teaching, suggestion, and motivation are found both in the references and in the knowledge available to one of ordinary skill in the art. . . . *Miller* et al. teaches the improved branched sulfonic polyester with lowered Tg. The low Tg provide advantage that the composition will not be brittle at low temperature, thus maintain its property.” *Id.* at 7. Appellants strongly disagree.

Miller, which is directed to hot-melt adhesives, teaches that branched polyesters with lower glass transition temperatures are “improved” and “provide advantage” **in the context of *Miller*'s desired properties**: “high bond strength under conditions of shock, stress, high humidity, and extremes of temperature.” *Miller* at 2. In contrast, *Lee* is

directed to hairstyling compositions exhibiting "low stickiness" and "good combing characteristics." One of ordinary skill in the art would not consider *Miller's* polyesters "improved" **in the context of Lee's invention** since these hot-melt adhesives have material properties, such as high bond strength, that would be incompatible with the properties required of *Lee's* hairspray compositions, such as low stickiness. Appellants submit that neither the references nor the knowledge available to one of ordinary skill in the art provide any teaching, suggestion, or motivation to modify and combine the references in the manner proposed by the Examiner. Accordingly, reversal of this rejection is requested.

III. CONCLUSION

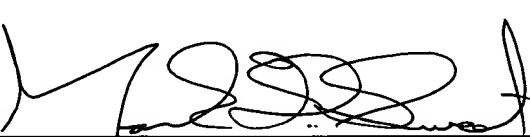
In view of the foregoing, Appellants respectfully request that the outstanding § 112 and § 103 rejections be reversed and withdrawn.

Please grant any extensions of time required to enter this Reply Brief and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: August 7, 2008

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